

REMARKS

The following remarks are being filed in response to the Office Action dated February 4, 2009. Accordingly, applicants submit that this response is being timely filed within two (2) months of the mailing of the Final Office Action, and applicants respectfully request a response from the USPTO within the original shortened statutory period for response.

Claims 9-15, 17-20 and 24-28 were pending in the present application with claims 9-15 and 25-28 being allowed. Applicants note that claims 17-20 and 24 were previously allowed or indicated as containing allowable subject matter in view of the cited prior art of record. None of the pending claims currently stand rejected in view of any prior art rejections.

Claims 17-20 and 24 only stand rejected in the Office Action under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse this rejection based on the following remarks and it is respectfully submitted that claims 9-15, 17-20 and 24-28 are in proper condition for allowance.

In the pages that follow below, applicant will set forth in detail:

- 1) In pursuing its rejection under 35 U.S.C. 101, USPTO personnel have not identified the features of the invention that would render the claimed subject matter statutory if recited in the claim, in accordance with MPEP § 2106; and
- 2) Claims 17-20 and 24 are not merely directed to an abstract idea or compilation of data.

Claim Rejections Under 35 U.S.C. § 101

Claims 17-20 and 24 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed based on the following remarks.

Summary of Invention Recited in Claims 17-20 and 24

Claims 17-20 and 24 are directed to a motion picture film copy or a motion picture film print bearing special marks that impart coded identification information into the motion picture film copy or a motion picture film print. Motion picture film copies or prints that are distributed to theaters can be individually coded with a coded identification number, such that specific identification numbers can be associated with corresponding locations to which the motion picture film copies or prints were distributed. The coded identification numbers can be placed in visible portions of the frames of the motion picture so that the coded identification numbers are projected onto the movie screen along with the images of the motion picture. When illegal copies of the motion picture are made (e.g., by pirates who illegally record a motion picture while they are watching it in the theater), those illegal recordings or copies will likewise record the coded identification numbers are projected onto the movie screen. In this manner, piracy can be combated by determining the location at which the illegal copy of the motion picture was made from the coded identification numbers identified in the pirated copies of the motion picture.

However, sophisticated pirates or counterfeiters can remove the portions of the illegal copies of the motion picture that contain the coded identification numbers to prevent the identity of the location from where the illegal copy was made from being identified.

In order to prevent the coded identification numbers appearing in the motion picture film copies or prints from being located by the pirates who may be making illegal copies of the motion picture, claims 17-20 and 24 recite that the coded identification numbers are placed onto the motion picture film copies or prints to have the appearance of defects to a viewer of the motion picture film copies or prints. For example, the defects may appear as dirt particles, color defects, scratches, or any combination of the foregoing defects, to prevent their inclusion in the motion picture film copies or prints from being identifiable. If a counterfeiter making illegal copies of a motion picture cannot identify coded identification numbers appearing in a motion picture they are viewing and recording, then the counterfeiter cannot remove the coded identification numbers from the illegal copies. Similarly, it is important that the coded

identification numbers do not interfere with the normal viewer of the motion picture's experience, such that the defects placed into the motion picture film copies or prints should minimize interference with the normal viewing of the motion picture.

MPEP § 2106 Requires the Examiner to Identify Features of the Invention that Would Render the Claimed Subject Matter Statutory if Recited in the Claim

MPEP § 2106 sets forth the Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility ("Guidelines") to assist examiners in determining, on a case-by-case basis, whether a claimed invention is directed to statutory subject matter under § 101. Clearly, as described briefly in the above summary of the features of claims 17-20 and 24 and in much greater detail in the written description of the present application, claims 17-20 and 24 are directed to the concept of inserted specialized marks into a motion picture film print that are formed to resemble defects in the motion picture when the motion picture is viewed such that these defects correspond to a coded identification number and such that they are substantially unnoticeable to an ordinary viewer. As such, claims 17-20 and 24 are clearly directed to patent eligible statutory subject matter under § 101. A further discussion supporting this conclusion is set forth below.

Applicants note that MPEP § 2106 sets forth:

If the invention as set forth in the written description is statutory, but the claims define subject matter that is not, the deficiency can be corrected by an appropriate amendment of the claims. In such a case, USPTO personnel should reject the claims drawn to nonstatutory subject matter under 35 U.S.C. 101, but identify the features of the invention that would render the claimed subject matter statutory if recited in the claim. (emphasis added)

However, no features have ever been identified by the present examiner that would render the claimed subject matter statutory if recited in any of claims 17-20 and 24. Thus, should the examiner desire to continue to assert the rejection of claims 17-20 and 24 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, then it is respectfully requested that the examiner comply with the Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility under MPEP § 2106 and identify the features of the invention that

would render the claimed subject matter statutory if recited in the claim. Since such features have never been identified in any Office Action, applicants respectfully request that the finality of the Office Action be removed and the applicants be provided with the opportunities they rightfully should have been provided in accordance with the Guidelines for determining subject matter eligibility.

Claims 17-20 and 24 Are Not Merely Directed to an Abstract Idea

35 U.S.C. § 101 recites:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

A motion picture film copy or a motion picture film print is a “manufacture” that falls within a statutory category of patent eligible subject matter under § 101. Applicants respectfully set forth that a motion picture film copy is an article of manufacture and not merely a compilation of data that could be considered an abstract idea. Applicants further note that the USPTO Board of Patent Appeals and Interferences has held that a sound recording falls within the scope of an article of manufacture under § 101. *Ex Parte Carver*, 227 U.S.P.Q. 465 (Bd. Pat. App. & Interferences 1985). Similarly, a motion picture film recording, just like a sound recording, is also a statutory article of manufacture under § 101.

USPTO Has Consistently Found Motion Picture Recordings Eligible Under § 101

For the present examiner to hold that a motion picture film print *per se* is ineligible for patent protection under § 101 as nothing more than a compilation of data is impermissibly in direct conflict with both the BPAI (holding that sound recordings are article of manufacture under § 101 in *Ex Parte Carver*) and the USPTO’s consistent and repeated history of granting patents to motion picture films (or their equivalent).

Just a brief search of the USPTO records revealed the following U.S. patents that were issued to similar statutory articles of manufacture under § 101:

<u>U.S. Patent No.</u>	<u>Claim Recitation</u>
4,308,327	1. A motion picture release print produced by . . .
4,366,217	1. An exposed and developed motion picture release print , comprising: ...
4,577,305	1. A motion picture film having a photographic sound-track for selective reproduction of monophonic sound . . .
5,675,379	10. A recording medium having recorded thereon moving picture signals having a bit stream obtained from ...
5,864,368	26. A signal recording medium having recorded thereon encoded picture signals produced by ...
5,991,500	7. A video signal record medium having recorded thereon a video signal comprised of ...
7,206,409	22. A security coded motion picture disposed on a media comprising: ...
	49. A security coded motion picture comprising: a motion picture recording comprised of a plurality of frames, ...

Applicants initially note that U.S. Patent No. 7,206,409, which was just issued by the U.S. Patent and Trademark Office in 2007 and which was also cited by the present Examiner in the present application in an Office Action dated December 18, 2007, claims a security coded motion picture comprising a plurality of motion picture scenes that include marks. Clearly, the U.S. Patent and Trademark Office found that U.S. Patent No. 7,206,409 was not merely “a compilation of data” directed to an “abstract idea,” but rather, in issuing this patent, the U.S. Patent and Trademark Office found that a security coded motion picture comprising a plurality of motion picture scenes that include marks is indeed a statutory article of manufacture under § 101.

As can be seen, the USPTO has repeatedly found that motion picture film prints are a type of media that are eligible for patent protection. As such, Applicants respectfully submit that the claimed motion picture film copy and motion picture film print are manufactures having a

practical application that clearly fall within a statutory category of patent eligible subject matter under § 101. Withdrawal of the § 101 rejection of claims 17-20 and 24 is hereby requested.

Response to Examiner's Assertion that Film Print Merely Constitutes a Compilation of Data

If applicants were merely attempting to claim a film print having a images stored thereon, then the examiner would be correct in asserting that the film print was merely a compilation of data. Additionally, if applicants were merely attempting to claim the printing of a coded identification number of some medium (whether it be film or paper), then the examiner would again be correct in asserting that claims directed to a film print simply containing a coded identification number would likely be considered a compilation of data. However, the examiner has failed to appreciate the features of the invention that are being claimed.

Claims 17-20 and 24 recite motion picture film prints or copies which are specially identified using identification codes by inserting small, separated marks in the visible portion of certain frames of the film prints or copies that resemble defects to a viewer of the motion picture film prints or copies. Further, other aspects of the claims recite that the size of each mark is selected to be close to the minimum size capable of being stored during video camera data compression while the location of each mark is also selected to minimize interference with the normal viewing of said film prints or copies.

The "abstract idea" would at most be considered the idea of fixing a code on a medium (e.g., writing a code on a piece of paper as described in the Office Acton). Applicants note that the rationale for denying patent protection to inventions addressed to abstract ideas that are "a mere compilation of data" is that the essence of its novelty does not reside in a physical structure or extension, but rather in concepts conveyed by the arrangement of words or data. In contrast, the motion picture film copy or a motion picture film print embodied in claims 17-20 and 24 very much resides in and is limited to the physical structure of the film copy or film print itself. The fact that marks are formed in the visible portion of the frames of the film copy or film print allow them to be projected onto a movie screen when played by a video projector. The fact that the marks are made to resemble defects in the film copy or film print allow them to also be projected onto the movie screen without interfering with the viewing experience and also without fear of identification codes represented by the marks from being identified by the counterfeiters.

Applicants further note that the Federal Circuit just recently stated in the *In re Bilski* decision that a claim that is drawn to a particular use, a specific application, is not drawn to the principle in the abstract. In *Bilski*, the Federal Circuit analyzed the Supreme Court's *Diamond v. Diehr* decision concluding that there is a distinction between those claims seeking to pre-empt the use of a fundamental principle (or abstract idea), on the one hand, and claims that seek to only foreclose others from using a particular application of that fundamental principle (or abstract idea). It is only if the claims pre-empt substantially all uses of the fundamental principle or abstract idea that they are considered to be not patent-eligible subject matter.

Similarly, in the present application, the applicants are not attempting to claim the abstract idea of a film print containing codes, nor are the applicants attempting to claim the abstract idea of a simply placing coded marks into a film print. Applicants' claims 17-20 and 24 would not pre-empt all uses of such abstract ideas. To the contrary, Applicants' claims 17-20 and 24 are specifically directed to a particular application in which specialized marks resembling defects are made in a motion picture film copy or film print that allow identification codes to be projected onto a movie screen so that they appear as defects (e.g., dust, scratches, etc.) to viewers so that such codes do not interfere with the viewing experience and so that such identification codes represented by the marks are not easily identified by counterfeiters.

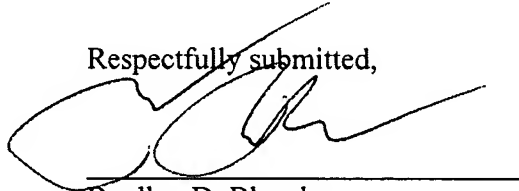
A motion picture film copy or a motion picture film print bearing special marks resembling defects in the film that serve to identify the film copy or film print is very much directed to a particular use and specific practical application, and thus are eligible for patent protection under § 101. Withdrawal of the § 101 rejection of claims 17-20 and 24 is hereby requested.

Conclusion

Applicant believes that this case is now in good condition for allowance, and an early Notice of Allowance is earnestly solicited for claims 9-15, 17-20 and 24-28. If a telephone or further personal conference would be helpful, the Examiner is invited to call the undersigned, who will cooperate in any appropriate manner to advance prosecution.

The Commissioner is directed and authorized to charge all additional required fees, except for the Issue Fee and the Publication Fee, to **Deposit Account Number 50-2638**. Please also credit any overpayments to said Deposit Account. Please ensure that Attorney Docket Number 092807-011000 is referred to when charging any payments or credits for this case.

Respectfully submitted,



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